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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,647	03/11/2004	Stephen J. Lafontaine	02LF-1	8137

7590 11/30/2004

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EXAMINER


SINGH, SUNIL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/798,647	Applicant(s) LAFONTAINE, STEPHEN J.	
	Examiner Sunil Singh	Art Unit 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: page 4 line 22, "internal" appears to be incorrect; page 5 line 3, "internal" appears to be incorrect. Page 13 line 14, "Fug. 8" appears to be a typographical error. Appropriate correction is required.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "34" has been used to designate both arrow and tunnel (see page 6). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "54a" has been used to designate both front portion of small diameter and rear portion of large diameter. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid

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abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The above mentioned claims are confusing because it appears as if applicant is mix and matching Species. For example, claim 1 is directed to Figures 1 and 4-7; claim 2 directed to Figures 10-11c. They are two patentably distinct inventions and thus claim 2 cannot depend from claim 1. In particular, claim 1 is not generic because the step of "placing an underground pipe in the in-ground tunnel while pulling the tool rearward from the tunnel toward the first trench" is not performed by Figures 10-11c; in that case the tool is pulled rearwardly after the pipe is placed not while the pipe is being placed.

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Claim 4 is confusing because it is not clear if applicant is claiming an apparatus claim or method claim. Claim 4 similarly is directed to Species shown in Figures 10-11c and therefore cannot depend from claim 1.

Claim 5 is confusing because it is not clear if applicant is claiming an apparatus claim or method claim.

Claim 8 directly contradicts claim 7 so it cannot depend from it.

Claim 14 is confusing since it is not clear if applicant is just claiming a piercing tool.

Claim 17 is confusing since it is not clear if applicant is just claiming a pipe connector.

Claim 23 lines 2-3 appear to be incorrect since the forward end of the pipe connector does not connect to the rod but instead with the pipe.

The claims are so replete with indefiniteness that the examiner is unable to determine the metes and bounds of the claims. Applicant needs to clarify all claims as to whether they are independent claims and if so whether they are directed to method claims or apparatus claims and further to which Species in particular (Specie I drawn to Figs. 1,4-7 and Specie II drawn to Figs. 10-11c).

Upon clarification is appears that a restriction requirement would be proper. For instance the piercing tool called for in claims 14, 24 do not need to perform the method steps called for in claims 1-3; the pipe connector called for in claim 17 is considered as a subcombination usable together with the tool called for in claim 14. Not to forget there are two patentably distinct Species, in particular Specie I drawn to Figs. 1,4-7 and Specie II drawn to Figs. 10-11c.

Insofar the claims are understood the following rejections have been made:

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Elliott (US 2349033).

Elliott discloses a method for installing underground pipe (21) under a ground supported structure, comprising: forming first and second trenches (22,23) in the ground on opposite sides of the structure; placing an axially elongated ground piercing tool (26) in the first trench with a ground piercing tip (25) of the tool facing the second trench; driving the tool through the ground under the structure toward the second trench to form an in-ground tunnel between the first and second trenches; and placing an underground pipe (21) in the in-ground tunnel while pulling the tool rearward from the tunnel toward the first trench, the step of placing the pipe in the in-ground tunnel comprises: replacing the ground piercing tip of the tool with a pipe connector (32) having a threaded forward end; attaching the pipe to the forward threaded end of the connector; pulling the tool and pipe rearward through the in-ground tunnel until the pipe extends between the first and second trenches; and disconnecting the connector from the pipe.

8. Claims 4,14-17 and 24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Epo document (EP0294740).

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Epo document discloses a system comprising an axially elongated ground piercing tool (2,3,4,6,7), the tool having a pointed tip portion (3) threaded to a threaded forward (2,4) end portion of an axially extending rod portion (6) of the tool; and a pipe (1) carried by the rod portion.

9. Claims 14,17-19,21,23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over LaFontaine (US 5950739). LaFontaine discloses an axially elongated ground piercing tool (28), the tool having a pointed tip portion (14) threaded to a threaded forward end portion of an axially extending rod portion (28) of the tool; a pipe connector (38).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday 8:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sunil Singh
Primary Examiner
Art Unit 3673



SS



11/23/04